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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,167	04/24/2000	CLAUS GODER	GK-GEY-1065	2203

26418 7590 05/22/2002

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NEW YORK, NY 10152

EXAMINER

FARAH, AHMED M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 05/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/530,167

Applicant(s)  
Goder et al.

Examiner  
A. Farah

Art Unit  
3739



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 5, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above, claim(s) 39-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1 6) ☐ Other:

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**DETAILED ACTION**

***Election/Restriction***

1. Claims 39-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made without traverse in Paper No. 5.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 23 and 32-35 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The alternative language "and/or" is improper and, therefore, renders the claims indefinite.

o/c

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 22-~~38~~ are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Telfair et al. U.S. Pat. No. 4,911,711.

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Telfair et al. disclose ophthalmic surgery apparatus for reshaping the surface/curvature of the cornea to correct vision defects. As shown in Figures 1, 2, and 8, the apparatus comprises:

- A) a pulsed excimer laser 11;
- B) a beam deflecting device 25, through which the laser beam is guided over the surface of the eye 13; and <sup>↑ (Col. 4, line 43)</sup>
- C) an optical element 22 for changing the distribution of the radiation intensity inside the laser beam cross-section, the optical element 22 including at least one optical device (trap 21) with microoptically active structure, wherein the microoptically active structure influences the intensity distribution of the laser beam cross-section in such a way that the laser beam, after passing through optical element 22, has a Gaussian intensity distribution (see Col. 3, line 47 to Col. 4, line 17).

In reference to claim 23, trap 21 of Telfair et al. is provided with a diffractive and/or refractive microoptically active structure and therefor is analogous to the optical element 15 of the instant claim. As shown in Fig. 2, trap 21 is introduced into or removed from the path of the laser beam.

In reference to claims 24-27, the invention of Telfair et al. is directed to methods for shaping and homogenizing the intensity inside the cross-section of a rectangular laser pulse from ultraviolet excimer laser so as to produce a circular laser beam with a Gaussian intensity distribution that is suitable for reshaping the cornea (see claim 1 and the abstract).

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In reference to claims 28-32, the surgical apparatus of Telfair et al. comprises a plurality of optical elements including: optical elements (filters 24), which are arranged on a movable carrier (rotatable wheel 56); a rotatable disc 66, which is placed in the optical path of the laser beam so as to influence the size of the spot area directed on the cornea; and a computer 30, which controls the functions of the optical elements.

In reference to claims 33 and 34, the computer 30 of Telfair et al. is coupled to a surface diagnostics device 17, and thereby detects the actual values/curvature of the corneal surface.

In reference to claims 35-38, the apparatus of Telfair et al. would inherently provide the methods as claimed.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the following reference.

- |                     |                            |
|---------------------|----------------------------|
| 1. Koziol et al.    | U.S. Pat. No. 4,838,266    |
| 2. Hanna et al.     | U.S. Pat. No. 5,284,477    |
| 3. Sumiya et al.    | U.S. Pat. No. 5,906,608    |
| 4. Ruiz             | U.S. Pat. No. 6,302,877 B1 |
| 5. Fleming et al.   | U.S. Pat. No. 6,285,001 B1 |
| 6. Sumiya           | U.S. Pat. No. 5,800,424    |
| 7. L'Esperance, Jr. | U.S. Pat. No. 4,951,663    |

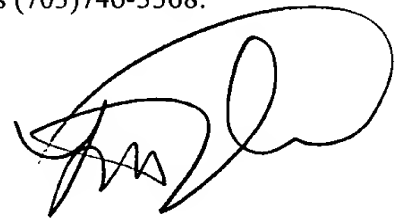
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Linda Dvorak, can be reached on (703) 308-0994. The fax number for the Examiner is (703)746-3368.

AF



05/13/02



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